

prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). This is the case we have here – that is, the cited prior art does not suggest the desirability of the cited combination.

The Office Action admits that Gehr fails to disclose the “qualification step” recited in claims 1, 10, and 19; and relies on Tatano for the “qualification step.” Specifically, the Office Action asserts that it would have been obvious to one of ordinary skill to include the concept of Tatano into the system of Gehr in order to prevent the error of the backup copying. The Office Action also admits that none of the references teaches using a hybrid optical disc in the “qualification step.” The Office Action relies on Iida to teach a hybrid optical disc. In particular, the Office Action contends that it would have been obvious to one of ordinary skill in the art to include Iida into the system of Gehr modified by Tatano to make the system more versatile.

Applicant respectfully submits, however, that Gehr relates to using copy buttons on a disc drive to automate the CD copying process and reduce the amount of knowledge and action required by users. Tatano discloses a system for preventing the error of backup copying for a recording medium; that is, preventing a master recording medium from being set as the copy destination recording medium. Iida discloses a system for easily and precisely determining the physical characteristic of recording media. Applicant respectfully notes that there is no objective motivation to combine these teachings to produce the claimed invention.

Applicant respectfully notes that Gehr does not disclose or suggest that it would be desirable to have a system for preventing a master recording medium from being set as the copy destination recording medium. Furthermore, neither Gehr nor Tatano suggests combining a system for creating copy buttons on a disc drive with a system for preventing the error of backup copying, and with a system for determining

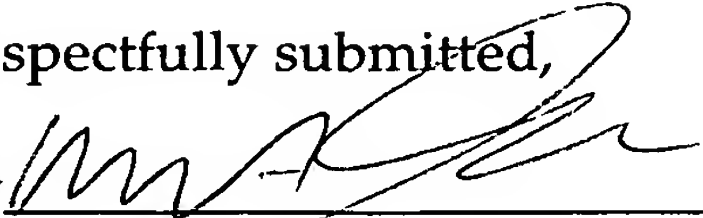
the physical characteristic of recording media. There is no teaching or suggestion within any of the cited references that provides a motivation to combine them. Accordingly, Applicant respectfully requests the withdrawal of the rejection and allowance of claims 1-27.

Claims 6, 15, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tatano in view of Gehr in view of Iida, further in view of Fairman et. al. U.S. Patent No. 6,898,172. The rejection is respectfully traversed.

Claim 6 depends from claim 1. Claim 15 depends from claim 10. Claim 24 depends from claim 19. As discussed above there is no motivation to combine the teachings of Tatano, Gehr, or Iida to produce the claimed invention. The Office Action relies on Fairman for disclosing "a dummy data determination step." Fairman, however, discloses a system to minimize the amount of data that must be written in a secondary writing operation to an optical disc. Applicant respectfully submits that there is no teachings or suggestions in Tatano, Gehr, or Iida that it would be desirable to have a system to minimize the amount of data that must be written in a secondary writing operation to an optical disc. Accordingly, Applicant respectfully requests the withdrawal of the rejection and allowance of the claims.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

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